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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/760,035

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Joseph J. Kubler

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MCANDREWS HELD & MALLOY, LTD  
500 WEST MADISON STREET  
SUITE 3400  
CHICAGO, IL 60661

EXAMINER

ROBERTS, BRIAN S

ART UNIT

PAPER NUMBER

2419

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/760,035	<b>Applicant(s)</b> KUBLER ET AL.	
	<b>Examiner</b> BRIAN ROBERTS	<b>Art Unit</b> 2419	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 February 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-34, 36-38, 54-59 and 78-133 is/are pending in the application.
- 4a) Of the above claim(s) 96-121 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-34, 36-38, 54-59, 78-95 and 122-129 is/are rejected.
- 7) ☒ Claim(s) 130-133 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

- Claims 22-34, 36-38, 54-59, 78-133 remain pending.
- Claims 96-121 have been withdrawn from consideration.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/17/2009 has been entered.

### ***Election/Restrictions***

Applicant's traversal of the restriction requirement in the Office Action dated 10/14/2008 in the reply filed on 02/17/2009 is acknowledged. The traversal is on the ground(s) that the Office has failed to establish that "there would be a serious burden if the restriction were not required" and failed to establish reasons for insisting on restriction. This is not found persuasive because 37 CFR 1.145 does not require establishing that "there would be a serious burden if the restriction were not required" in the instant case where the newly submitted claims are independent or distinct from the invention originally claimed. Furthermore, the Examiner has met the requirements of 37 CFR 1.145 by showing that the newly submitted claims are independent or distinct from

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the invention originally claimed because the subcombinations of the original invention and the new invention do not overlap in scope and are not obvious variants, and at least one subcombination is separately usable. In the instant case, subcombination of the newly submitted invention has separate utility such as selecting a transmission data rate for transmissions between two stations.

The requirement is still deemed proper and is therefore made FINAL.

Claims 96-121 are withdrawn from consideration.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the portable terminal device of claim 1 comprising all claimed components including the claimed second transceiver must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

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consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). The numbering for claim 35 has been skipped. There is no claim 35.

Claims 130-133 are objected to as being dependent on withdrawn claims 96 and 109.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 22-34, 36-38, 54-59, 78-95, and 122-129 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- In reference to claim 22

In claim 22 lines 13-15, the limitation "a second receiver supporting a short range wireless communication link, the portable terminal device transmitting, via the wireless packet network, digital voice packets created using digitized voice information received by the second receiver" was not described in the original disclosure, and thus constitutes new matter. Furthermore, in lines 16-22, the limitation " wherein the portable terminal device evaluates a message wirelessly received from the base station and sends to the base station an indication of a data rate based on the evaluation; and wherein the portable terminal device receives digital voice packets transmitted by the base station at a data rate selected by the base station based upon the indication of a data rate" was not described in the original disclosure, and thus constitutes new matter.

- In reference to claim 30

In claim 30 lines 9-11, the limitation "a second receiver supporting a short range wireless communication link, wherein the portable terminal device transmits, via the

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wireless packet network, digital voice packets created using digitized voice information received by the second receiver" was not described in the original disclosure, and thus constitutes new matter. Furthermore, in lines 13-18, the limitation " wherein the circuit evaluates a message wirelessly received from the base station and sends to the base station an indication of a data rate based on the evaluation; and wherein the circuit receives digital voice packets transmitted by the base station at a data rate selected by the base station based upon the indication of a data rate" was not described in the original disclosure, and thus constitutes new matter.

- In reference to claim 54

In claim 54 lines 13-17, the limitation "receiving digitized voice information using a short range wireless communication link; creating digital voice packets from the digitized voice information; sending the digital voice packets via the wireless packet network" was not described in the original disclosure, and thus constitutes new matter. Furthermore, in lines 20-23, the limitation " wherein the portable terminal device receives sender of the received digital voice packets at a selects the data rate selected by a base station serving a plurality of portable terminal devices, based upon the indication of a data rate sent by the portable terminal device" was not described in the original disclosure, and thus constitutes new matter.

- In reference to claim 78

In claim 78 lines 15-19, the limitation "receiving digitized voice information using a short range wireless communication link; creating digital voice packets from the digitized voice information; sending the digital voice packets via the wireless packet network" was not described in the original disclosure, and thus constitutes new matter. Furthermore, in lines 22-25, the limitation "wherein the portable terminal device receives digital voice packets at a data rate selected by a base station serving a plurality of portable terminal devices, based upon the indication of a data rate sent by the portable terminal device" was not described in the original disclosure, and thus constitutes new matter. "Computer-readable medium" and the limitation "A computer-readable medium, having stored thereon a computer program having a plurality of code sections for operating a portable terminal device supporting voice communication via a wireless packet network, the code sections executable by a processor for causing the processor to perform the operations" was disclosed or defined in the original disclosure, thus the limitation is considered new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 54-59, 78-86, 93-95, and 126-129 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- In reference to claim 54



In lines 10-11, the limitation "enabling conversion of sound to digitized voice information" renders the claim indefinite. The limitation is not an active positively recited step. The examiner recommends the limitation to read --converting sound to digitalized voice information--.

- In reference to claim 78

In lines 10-11, the limitation "enabling conversion of sound to digitized voice information" renders the claim indefinite. The limitation is not an active positively recited action. The examiner recommends the limitation to read --converting sound to digitalized voice information--.

- In reference to claim 55-59, 79-86, 93-95, and 126-129

Claims 55-59, 79-86, 93-95, and 126-129 are rejected as being dependent on rejected independent claim 54 or 78.

### ***Response to Arguments***

Applicant's arguments filed 02/17/2009 have been fully considered but they are not persuasive.

- In the Remarks on pg. 19 of the Amendment, the Applicant contends that "computer-readable storage" or "computer-readable medium" is not new matter because mobile terminal 5523 inherently has a computer-readable

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- medium that stores the software of the mobile terminal 5523 for execution by a processor.
- The Examiner respectfully disagrees. "Computer-readable medium" and the limitation "A computer-readable medium, having stored thereon a computer program having a plurality of code sections for operating a portable terminal device supporting voice communication via a wireless packet network, the code sections executable by a processor for causing the processor to perform the operations" was disclosed or defined in the original disclosure, thus the limitation is considered new matter.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN ROBERTS whose telephone number is (571)272-3095. The examiner can normally be reached on M-F 10:00-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wing Chan can be reached on (571) 272-7493. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BSR/  
03/03/09

/Hong Cho/  
Primary Examiner, Art Unit 2419